

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and present specification.

Status of the Claims

In the present Reply, claim 13 has been amended. Also, claims 2 and 26-28 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Further, claim 29 has been added. Thus, claims 1, 3-25 and 29 are pending in the present application.

No new matter has been added by way of these amendments because each amendment and new claim is supported by the present specification and/or editorial in nature. For example, the amendment to claim 13 merely places this claim into independent form by incorporating the subject matter of the base claim. New claim 29 drawn to another embodiment of the present invention has been added for consideration. Support for new claim 29 is found at least in originally filed claims 1 and 5.

The amendment to the present specification is supported by originally filed and canceled claim 6. No new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to Specification

The specification is objected as stated in paragraph 4 of the Office Action. Applicants respectfully submit that the amendment to the specification as presented herein obviates this objection. Withdrawal of this objection is respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1, 3, 8-20 and 22-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernier et al. '571 (U.S. Patent No. 5,834,571). Applicants respectfully traverse as follows, and reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner states that the difference between the instantly pending claims as issue versus the Bernier '571 disclosure is that the claimed process comprises a continuously operated control valve (see the Office Action at page 4, last paragraph). Then, M.P.E.P. § 2144.04 is cited as the basis for modifying the Bernier '571 disclosure to match what is instantly claimed (at pages 5-6 of the Office Action). Applicants respectfully submit that this modification is improper, and that a *prima facie* case of obviousness has not been established.

No *prima facie* case of obviousness: lack of disclosure of all claimed features and improper modification of Bernier '571

The Examiner cites section V of M.P.E.P. § 2144.04 in the Office Action. With regard to the section entitled "*E. Making Continuous*" of M.P.E.P. § 2144.04, the *In re Dilnot* case is cited. However, a review of *Dilnot* reveals that this case stands for the proposition that the addition of a

method step in a claim directed to a product, wherein the product is not patentably distinguishable from the prior art, cannot impart patentability to an old product. However, that is not the issue here. Instead, the instantly pending claims are directed to methods, and not products such as that discussed in the *In re Dilnot* decision. Thus, the instant rejection improperly uses or cites M.P.E.P. § 2144.04 as well as the *Dilnot* case, as the presently pending claims are directed to methods. Thus, the Bernier '571 reference has been improperly modified to account for all features of the disputed claims. Accordingly, Applicants respectfully submit that the instant rejection is improper and request withdrawal thereof.

In this regard, U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Here, not even the initial requirement of disclosure of all claimed features has been satisfied. More specifically, the Bernier '571 reference cannot be properly modified, as explained above, to account for all instantly claimed features. Because Bernier '571 fails to disclose all claimed features (e.g., a continuously operated control valve), this rejection under § 103(a) has been

overcome. Under *In re Vaeck*, reconsideration and withdrawal of this rejection are respectfully requested.

No *prima facie* case of obviousness: lack of requisite motivation and/or reasonable expectation of success

Applicants respectfully submit that the requisite motivation and/or reasonable expectation of success are lacking. *Vaeck*; *Kotzab*; *Fine*.

Based upon a whole teaching or disclosure of the cited Bernier '571 reference, one of ordinary skill in the art would understand that this reference is directed to intermittent (or discontinuous) withdrawal of polymers. In this regard, the difference between the present invention and the Bernier '571 reference is that the present invention involves the withdrawal of agglomerates that do not plug the continuous outlet system. Applicants submit that the continuous outlet has smaller dimensions versus the discontinuous line, as can be seen from the example and comparative example, and can therefore the Bernier '571 embodiment can easily be clogged or plugged by the agglomerates. While the cited Bernier '571 reference says that polymers may be continuously withdrawn from the reactor (the Office Action refers to, e.g., column 19, lines 10-13 of the reference), one of ordinary skill in the art would not be motivated, nor reasonably expect to be successful, in achieving the present invention based on such disclosure. This is because there is no disclosure in the cited Bernier '571 reference of a need for a separate withdrawal system for agglomerates. Any suggestion to the contrary amounts to an impermissible level of hindsight reconstruction. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d

1596, 1600 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Again, as understood by the skilled artisan, the whole teaching of Bernier ‘571 is directed to intermittent (or discontinuous) withdrawal of polymer. Though the Examiner refers Applicants to certain parts of Bernier ‘571 for disclosing continuous withdrawal, Applicants respectfully submit that the only text referring to continuous withdrawal is the sentence mentioning that the polymer can be withdrawn either continuously or intermittently. Applicants note that any cited reference used for a rejection under 35 U.S.C. § 103(a) must be considered in its entirety, *i.e.*, as a whole, including those portions that would lead away from a claimed invention. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Upon consideration of the entire Bernier ‘571 reference, one of ordinary skill in the art would realize this reference is directed to intermittent (or discontinuous) withdrawal of polymer, and not what is instantly claimed. Thus, Applicants submit that the requisite motivation is lacking. *In re Vaeck*.

Applicants further note that while the cited reference need not expressly teach that the disclosure contained therein should be combined with another, *see Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combining references “must be clear and particular”. *See In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, there is no guidance in the cited Bernier ‘571 reference to achieve the methods as presently claimed, and that the only text referring to continuous withdrawal is the sentence mentioning that the polymer can be withdrawn either continuously or intermittently. Thus, the requisite motivation is lacking for this reason as well.

Applicants add that, likewise, it is noted that an “invitation to explore” cannot form a basis for an Examiner’s rejection under 35 U.S.C. § 103(a). *See Ex parte Obukowicz*, 27 USPQ2d 1063 (B.P.A.I. 1992). In other words, picking and choosing elements from a reference to achieve the presently claimed methods equals an impermissible invitation to explore. Thus, Applicants respectfully submit that requisite reasonable expectation of success is also lacking.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

Application No. 09/831,600
Amendment dated September 1, 2005
Reply to Office Action of June 1, 2005

Docket No.: 0365-0501P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 1, 2005

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant